REMARKS

I. Claim Rejections - 35 USC §112

The Examiner rejected claims 1-19 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Examiner argued that the phrase "converting said book files from JDF into a master book embodied in common normal format (CNF) files" renders the claim language indefinite in claim 1.

The Applicant respectfully disagrees with this assessment and notes that claim 1 has been amended to remove the limitation wherein the conversion to equipment specific format from CNF includes the *JDF definitions*.

The Examiner has argued that the limitation of converting the book files from JDF to CNF renders the claim indefinite as the Examiner argues that both JDF and CNF are XML schema. The Examiner asks are these two types of XML different?

The Applicant submits that the two types of file formats (JDF and CNF) are indeed different. XML is a general purpose specification for creating markup languages. XML (Extensible Markup Language) allows the user to define the markup elements, providing a basic syntax to be used in the specification language. XML specifies lexical grammar and parsing requirements.

XML includes several *different* markup languages/formats which all utilize the XML specification in the creation of the markup languages. JDF and CNF are two of those differing markup language formats. Other formats utilizing XML (not related to the current application and chosen randomly from Wikipedia) may include formats such as, Channel Definition Format (CDF), Translation Memory eXchange (TMX), and Medical Markup Language ((MML). All of these formats utilize the XML specification. Is the Examiner saying that <u>all</u> of the over 100 different XML markup

languages are one and the same simply because they utilize the same XML specification? The Applicant submits that one can convert JDF to CNF as they are different *formats* within the XML *language group*.

The Examiner asks where it is specifically stated in the Applicant's specification that JDF is converted to another form. This is disclosed in FIG. 1, step 110 and in paragraph [0022] as follows:

> "This compilation of information is gathered in Job Definition Format (JDF). The book files are then *converted* into a Mastered Book embodied within a Common Normal Format (CNF) files as shown in step 110. The Common Normal Format is a universal format, devoid of any particulars unique to the administration of the system or rendering equipment."

Therefore, the Applicant has shown that there are several different XML formats and JDF and CNF are two of those different formats. Additionally, the Applicant has shown that the specification clearly states the JDF is converted into CNF.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §112, second paragraph, rejections of claims 1-19 be withdrawn.

II. Claim Rejections - 35 USC §103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

> "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and

2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

Kato in view of Sangroniz

The Examiner rejected claims 1, 2, 9-11, 14-17, 20, 21, 28-30 and 33-36 under 35 U.S.C. §103(a) as being unpatentable over Kato (U.S. Patent Publication No. 2003/0103236) in view of Sangroniz (U.S. Patent Publication No. 2005/0050466).

Regarding claim 1, the Examiner argued that Kato discloses a print-on-demand method for creating and reproducing books by heterogeneous reproduction systems, said method comprising the steps of:

a) obtaining book files from at least one of a memory, scanner and network (citing FIG. 19, the local hard disk or network drive is used to store, or obtain, a book file that can be printed in the system by the local or network printer). The Examiner argued that also, the data network connecting the client PC to the document management server can be considered as the data network used to obtain book files consisting of contents related to pages and chapters of a book. The Examiner argued that the content of the book files are obtained from a computer memory in an intermediate format that includes print attributes in JDF (citing Kato FIG. 19, paragraphs [0056]-[0062] and [0105]-[0121]).

The Examiner further argued that the book files including book identification information and book production information, wherein the book files are compiled into a digital representation of a book targeted for reproduction (i.e. the application (105), citing FIG. 1) is used to issue a print request to an intermediate code generation module (106), that generates a book in coded form, which is clearly digital code since all computers operate and read digital information. The Examiner argued that the book generated in an intermediate code also contains print attribute designation data in JDF that performs the feature of determining how the print job is to be produced (e.g. double or single sided printing, etc.), which is analogous to book production information (citing Kato FIGS. 1, 8 and 12; paragraphs [0068]-[0075] and [0115]-[0120];

b) converting the book files from JDF into a master book embodied in common normal format (CNF) files that are reproduction system and solution-independent (arguing that the intermediate code produced from using the information regarding the original of each page and the JDF is considered by the Examiner as the common normal format since this code is independent from reproduction system and it is coded as intermediate file format data. The Examiner

argued that several files can be combined together, or pre-processed, into a complete book file, which the Examiner considers as a mastered book. The Examiner argued that with different pages and chapters able to be added to an already existing book and the pages are represented by PDF or EMF combined with the attributes in JDF or DEVMODE, the feature of having book files converted, or processed, into a complete book and embodied in a language independent from the reproduction system performs the above feature, citing Kato paragraphs [0077] - [0100] and [0120].);

c) storing the CNF files in memory as a mastered book (i.e. the Examiner argued that the intermediate code storage module (107) is used to store the intermediate code, considered as common normal format files, that represents the data pertaining to the book to be printed). The Examiner argued that (citing FIG. 21), the image data is stored in the intermediate code storage module before further processing for printing or producing the book, which concurs with the feature of having the files stored in memory representing the book to be printed that contains all the contents related to the book to be produced; (citing Kato FIG. 21; paragraphs [0115]-[0120]);

d) determining if the CNF files need to be converted into equipment specific format files based on a book reproduction system to be utilized for reproduction and if conversion is necessary, thereafter (The Examiner argued, in the system, when processing the book files, an error can occur in the system. The Examiner further argued that when a generation of an error in outputting information in the printer occurs, the system detects the pages in which errors have been made. The Examiner stated that shown in FIG. 4 is the detection of this information. The Examiner argued that different processes take place depending on the situation regarding sheet error, however, regardless of the different processes; the sheet is eventually re-printed in FIG. 7. The Examiner argued that based on the error processing shown in FIG. 3, the system determines if an error occurs in the output process. Then the system determines which files that are in an intermediate format

need to be reprinted. Finally, the Examiner argued that in FIG. 7, the system determines which pages need to be reprinted and generates PDL data from the book files in intermediate code. The Examiner cited Kato FIG. 3-7 and paragraphs [0131] - [0158]);

e) converting the CNF files into equipment specific format files including JDF definitions that match the needs of a book reproduction system (i.e. in the system, the intermediate code generation module was used to convert the original data and the print attribute data, which is represented in JDF, into intermediate code data. The Examiner argued that this information is stored in the intermediate code memory. The Examiner argued that next, the system then obtains the intermediate code and converts the code into print data (e.g. PDL) in order for the printer to receive information in a format that is recognizable to the printer. The Examiner argued that the data converted to PDL is analogous to converting previous data into data that is specific to the printing equipment used in the system in order to match the pre-printing requirements of the printer so that the printer is able to recognize the information and output the print data. The Examiner argued that since the intermediate data includes the JDF and the intermediate data is converted into PDL, or print data, the above feature of converting the intermediate files into equipment specified files that includes the contents of the JDF information is performed; (citing FIG. 21), paragraphs [0115]-[0120]); and

f) reproducing said book from information comprised by said book reproduction system (i.e. the local or network printers shown in FIG. 19 or the printers connected to the LAN (104) shown in FIG. 1 are considered as the book reproducers that are able to output a book from the information converted into PDL that is interpreted by the printer for printing (citing FIGS. 1, 19 and 21; paragraphs [0115]-[0120]).

However, the Examiner admitted that Kato fails to specifically teach obtaining book files in job definition format (JDF). The Examiner argued however, that this is well known in the art as evidenced by Sangroniz.

The Examiner argued that Sangroniz discloses obtaining book files in JDF. The Examiner argued that the system of Sangroniz is similar to the system of Kato in the manner in which both systems involve a client device sending printing information to an apparatus to be printed. However, the Examiner argued that in Sangroniz, the print facility that receives job ticket information, the job ticket is described in JDF format. This same job ticket is received from a client through a network, or from a storage device. The Examiner argued that since the Kato device can consist of a host computer and a printer or consists only of one printing apparatus, the feature of obtaining information in JDF into a single apparatus can perform the above feature (citing Kato paragraphs [0008] - [0011].

The Examiner argued that therefore, in view of Sangroniz, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of obtaining book files in JDF, incorporated in the device of Kato, in order to obtain job tickets submitted to a printing system that is expressed in the JDF format (citing Sangroniz paragraph [0002]).

The Applicant respectfully disagrees with this assessment and notes that claim 1 has been amended to include the limitation of "storing said CNF files in memory within a repository as a mastered book". This is disclosed in the Applicant's specification in paragraph [0022].

The Applicant's invention provides a print-on-demand system and method for creating and reproducing books by heterogeneous systems. This is accomplished by storing the book files in a *repository* for later use in a file format (CNF) that is reproduction system and solution-independent. *After* a book order is received, the CNF book file is retrieved from the repository and converted to equipment specific format (if needed by the utilized reproduction system) and printed or formatted as an e-book. Kato in view of Sangroniz does not disclose storing the book files in a reproduction system and solution-independent format in a repository.

Additionally, the Examiner has argued that Kato discloses step b) of converting the book files from JDF into CNF as the Examiner argues that the

intermediate code is considered as CNF. Kato, however, refers to the *original* file as "intermediate code" (Kato paragraph [0059]). The Examiner seems to argue that the step of "converting the book files from JDF to CNF" is disclosed in Kato by the argument that Kato does *not* convert or need to convert the files. Even if this were true of the Kato reference, the Applicant's step b) of converting the files from JDF to CNF is therefore, *by the Examiner's own admission*, not disclosed.

The Examiner has included the Sangroniz reference for disclosing JDF format, however, that disclosure still does not disclose, anticipate or render obvious the Applicant's step of converting the obtained JDF files into CNF format.

The Examiner has cited Kato for the disclosure of step d). The Examiner's argument states that the determination *if* an error in Kato has occurred anticipates the step of *determining* if the CNF files need to be converted to equipment specific files. Kato clearly discloses that the files in which an error has occurred have *already been converted* to equipment specific files before an error has occurred. this is shown in Kato in paragraph [0135] and in FIG. 3, step, S34. Kato step S37 is disclosed *after* the step of converting the files to ESF. Therefore, Kato does not determine *if* the files need to be converted; only disclosing that the files *are* converted. Kato does not make *any* determination to whether the files *need* to be converted, simply disclosing that the files are always converted with the step of "Generate print data from intermediate code" (S34). Kato does indeed determine if an *error* has occurred, but does not disclose the step of determining if the files need to be converted to ESF.

Therefore, Kato in view of Sangroniz does not disclose: 1) converting the book files from JDF into CNF, 2) storing the CNF files in memory within a repository and 3) determining if the CNF files need to be converted to equipment specific files.

Kato in view of Sangroniz therefore fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claim 1 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35

U.S.C. §103(a) rejection of claim 1 based on Kato in view of Sangroniz be withdrawn.

Regarding claim 2, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein said book in step a) is originally in the form of electronic files (i.e. the file stored in the system is converted into an electronic file in the system; (citing paragraph [0053]).

Regarding claim 9, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued Kato discloses the method in claim 1, wherein step d) comprises the step of: acquiring or generating hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered as producing or generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]).

Regarding claim 10, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 9, wherein said book production information includes information pertaining to the printing information used by the printing equipment in the system; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]).

Regarding claim 11, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 9, wherein said book production information comprises printing information (i.e. the book printing attribute information includes information pertaining to the binding information used by the equipment that will perform the book binding operation; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]).

Regarding claim 14, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein step d) further comprises the step of; acquiring or generating hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered as producing or generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]).

Regarding claim 15, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein for electronic books, said book production information comprises security information (i.e. in the system, the qualification of the user to print is checked in the system. The Examiner argued that the qualifications of the user that is checked can be considered as security information; (citing paragraph [0111]).

Regarding claim 16, the Examiner argued that the teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein for electronic books, said book production information comprises viewing capabilities (i.e. in the system, when opening a book file using the bookbinding application, the display methods that are designated by the user, considered as viewing capabilities, affects how the job is viewed on the display. The Examiner argued that when displaying the image data, the manner in which the book is produced can be displayed. The Examiner argued that this is an example of the system acquiring displaying capability information from the requester of information; (citing paragraph [0112] and [0113]).

Regarding claim 17, the Examiner argued that teachings of Kato and Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein for electronic books, said book production information

comprises printing capabilities (i.e. in t he system, when obtaining e-book creation information, which is analogous to the book production information, the printing capabilities of the requester is obtained; (citing FIGS. 1-3, paragraphs [0007]-[0023]).

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejection of independent claim 1 applies equally against the rejections of dependent claims 2, 9-11, and 14-17. As submitted above, Kato in view of Sangroniz does not disclose all of the Applicant's claim 1 steps.

Therefore Kato in view of Sangroniz fails in the aforementioned *prima facie* anticipation test as each and every limitation of the Applicant's claims 2, 9- 11, and 14- 17 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(e) rejections of claims 2, 9- 11, and 14- 17 based on Kato in view of Sangroniz be withdrawn.

Regarding claim 20, the Examiner argued that Kato discloses a print-on-demand system for creating and reproducing books by heterogeneous reproduction workflows, said system comprising: at least one of a scanner, memory and data network for obtaining book contents for a book targeted for reproduction (i.e. when viewing figure 19, the local hard disk or network drive is used to store, or obtain, a book file that can be printed in the system by the local or network printer. The Examiner argued that also, the data network connecting the client PC to the document management server can be considered as the data network used to obtain book files consisting of contents related to pages and chapters of a book; (citing FIG. 19; paragraphs [0056]-[0062] and [0105]-[0113]);

a book file generator adapted to generate a digital representation of said book targeted for reproduction into book files including book identification information and book production information in job definition format (JDF) (i.e. the application (105), shown in FIG. 1, is used to issue a print request to an intermediate code generation module (106), that generates a book in coded form,

which is clearly digital code since all computers operate and read digital information. The Examiner argued that the book generated in an intermediate code contains information that expresses the original of each page by a detailed format, which is considered as book identification information. The Examiner argued that the intermediate code also contains print attribute designation data in JDF that performs the feature of determining how the print job is to be produced (e.g. double or single sided printing, etc.) which is analogous to book production information; (citing FIGS. 1, 8 and 12; paragraphs [0068]-[0075] and [0115]-[0120]);

a common normal format converter adapted to convert said book files into a common normal format that is reproduction system and solution-independent (i.e. the intermediate code produced from using the information regarding the original of each page and the JDF is considered as the common normal format since this code is independent from the reproduction system and it is coded as intermediate file format data; (citing paragraph [0120]);

a book file memory adapted to store common normal format files representing said book targeted for reproduction as a mastered book (i.e. the intermediate code storage module (107) is used to store the intermediate code, considered as common normal format files, that represents the data pertaining to the book to be printed. The Examiner argued that citing in FIG. 21, the image data is stored in the intermediate code storage module before further processing for printing or producing the book, which concurs with the feature of having the files stored in memory representing the book to be printed that contains all t he contents related to the book to be produced; (citing FIG. 21, paragraphs [0115]-[0120]);

an equipment specific format file converter adapted to convert common normal format files into a equipment specific format files including JDF definitions matching the needs of a book reproduction equipment being utilized to reproduce the book (i.e. in the system, the intermediate code generation module was used to

convert the original data and the print attribute data, which is represented in JDF, into intermediate code data. The Examiner argued that this information is stored in the intermediate code memory. The Examiner argued that next, the system then obtains the intermediate code and converts the code into print data (e.g. PDL) in order for the printer to receive information in a format that is recognizable to the printer. The Examiner argued that the data converted to PDL is analogous to converting previous data into data that is specific to the printing equipment used int eh system in order to match the pre-printing requirements of the printer so that the printer is able to recognize the information and output the print data. The Examiner argued that since the intermediate data includes the JDF and the intermediate data is converted into PDL, or print data, the above feature of converting the intermediate files into equipment specific files that includes the contents of t he JDF information is performed; (citing FIG. 21; paragraphs [0115]-[[0121]); and

a book reproducer adapted to reproduce the book from information comprised by the equipment specific format files (i.e. the local or network printers shown in FIG. 19 or the printers connected to the LAN (104) shown in FIG. 1 are considered as the book reproducers that are able to output a book from the information converted into PDL that is interpreted by the printer for printing; (citing FIGS. 1, 19 AND 21; paragraphs [0115]-[0121]).

However, the Examiner admitted that Kato fails to specifically teach obtaining book files in job definition format (JDF). The Examiner argued however, that this is well known in the art as evidenced by Sangroniz.

The Examiner argued that Sangroniz discloses obtaining book files in JDF. The Examiner argued that the system of Sangroniz is similar to the system of Kato in the manner in which both systems involve a client device sending printing information to an apparatus to be printed. However, the Examiner argued that in Sangroniz, the print facility that receives job ticket information, the job ticket is described in JDF format. This same job ticket is received from a client through a network, or from a storage device. The Examiner argued that since the Kato device

can consist of a host computer and a printer or consists only of one printing apparatus, the feature of obtaining information in JDF into a single apparatus can perform the above feature (citing Kato paragraphs [0008] - [0011].

The Examiner argued that therefore, in view of Sangroniz, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of obtaining book files in JDF, incorporated in the device of Kato, in order to obtain job tickets submitted to a printing system that is expressed in the JDF format (citing Sangroniz paragraph [0002]).

The Applicant respectfully disagrees with this assessment and notes that claim 20 has been amended similar to method claim 1 with the additional limitation of "storing said CNF files in memory within a repository as a mastered book".

Therefore the argument presented above against the rejection of claim 1 applies equally against the rejection of claim 20.

As submitted above, Kato in view of Sangroniz does not disclose: 1) converting the book files from JDF into CNF, 2) storing the CNF files in memory within a repository and 3) determining if the CNF files need to be converted to equipment specific files.

Therefore Kato in view of Sangroniz fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claim 20 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 20 based on Kato in view of Sangroniz be withdrawn.

Regarding claim 21, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said book in step a) is originally in the form of electronic files (i.e. the file stored in the system is converted into an electronic file in the system; (citing paragraph [0053]).

Regarding claim 28, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the

system in claim 20, wherein said equipment specific format converter comprises; a book production information generator adapted to generate hard copy book production information (i.e. when the system produces information related to t he print attribute of the print job, this is considered as producing or generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]).

Regarding claim 29, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein said book production information comprises printing equipment information (i.e. the book printing attribute information includes information pertaining to the printing information used by the printing equipment in the system; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]).

Regarding claim 30, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein said book production information comprises binding equipment information (i.e. the book printing attribute information includes information pertaining to the binding information used by the equipment that will perform the book binding operation; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]).

Regarding claim 33, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said equipment specific format converter comprises: a book production information generator adapted to generate hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered by the Examiner as producing generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued

that this information is created by the bookbinding application (1040); (citing paragraph [0058]).

Regarding claim 34, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein for electronic books, said book production information comprises security information (i.e. in the system, the qualification of the user to print is checked in the system. The Examiner argued that the qualifications of the user that is checked can be considered as security information; (citing paragraph [0111]).

Regarding claim 35, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein for electronic books, said book production information comprises viewing capabilities (i.e. in the system, when opening a book file using the bookbinding application, the display methods that are designated by the user, considered as viewing capabilities, affects how the job is viewed on the display. The Examiner argued that when displaying the image data, the manner in which the book is produced can be displayed. The Examiner argued that this is an example of the system acquiring displaying capability information from the requester of information; citing paragraph [0112] and [0113]).

Regarding claim 36, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein for electronic books, said book production information comprises printing capabilities (i.e. in the system, the printing attributes are related to the book file being printed is considered as the printing capabilities since these attributes define the manner in which to develop or create the book file in the printer; citing 1, 19 and21; paragraphs [0068]-[0075] and [0120]).

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejection of independent claim 20 applies equally against the rejections of dependent claims 21, 28-30, and 33-36.

As submitted above, Kato in view of Sangroniz does not disclose: 1) converting the book files from JDF into CNF, 2) storing the CNF files in memory within a repository and 3) determining if the CNF files need to be converted to equipment specific files.

Therefore Kato in view of Sangroniz fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims 21, 28-30, and 33-36 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 21, 28-30, and 33-36 based on Kato in view of Sangroniz be withdrawn.

Kato in view of Sangroniz and Warmus

The Examiner rejected claims 3, 12, 13, 22, 31 and 32 under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Sangroniz and further in view of Warmus (U.S Patent No. 6,332,149).

Regarding claim 3, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato fails to teach the system in claim 1, wherein said book in step a) is originally in the form of a hard copy, and step a) further comprises the steps of: scanning the components of said book; and converting scanned components of said book into said digital representation.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses wherein said book in step a) is originally in the form of a hard copy, and step a) further comprises the steps of: scanning the components of said book (i.e. in the system, a scanner can be used to scan an input copy, citing Warmus col. 8, lines 8-30); and converting scanned components of said book into said digital representation (i.e. the Examiner argued that like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information). The Examiner argued that with the scanning of an input copy and producing a movie or some

non-static information, the conversion of scanned information into a movie or other non-static information is understood to be in a digital representation; (citing Warmus col. 8, lines 8-30).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book in step a) is originally in the form of a hard copy, and step a) further comprises the steps of: scanning the components of said book and converting scanned components of said book into said digital representation in order to have a scanner which scans an input copy (citing Warmus, col. 8, lines 8-10).

Regarding claim 12, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein in step d) further comprises the step of: via a Processor, creating a bitmap of the book block (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17, paragraph [0082]).

The Examiner admitted that however, Kato fails to teach Raster Image Processor. The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses Raster Image Processor (i.e. like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus discloses having a RIP Raster Image Processor) used to create bitmaps of book pages that can be displayed; (citing FIG. 6, col. 8, lines 63-67, col. 9, lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a Raster Image Processor creating a bitmap of the book block in order to have a display device display pages (citing Warmus, col. 7, lines 24-31).

Regarding claim 13, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein step d) further comprises the step of: via a Processor, creating a bitmap of the book cover (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17, paragraphs [0070] and [0082]).

The Examiner admitted that however, Kato fails to teach Raster Image Processor. The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus disclosed having a RIP used to create bitmaps of book pages, which includes cover pages, which can be displayed; (citing FIG. 6, col. 8, lines 63-67, col. 9, and lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a RIP creating a bitmap of the book cover in order to have display device display pages (citing Warmus, col. 7, lines 24-31).

Regarding claim 22, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner admitted that however, Kato fails to teach the system in claim 20, wherein said book in step a) is originally in the form of a hard copy, and said book file generator further comprises: a book scanner adapted to scan the components of said book; and a scanned component converter adapted to convert scanned components of said book into said digital representation.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses wherein said book in step a) is originally in the form of a hard copy, and said book file generator further comprises: a book scanner adapted to scan the components of said book (i.e. in the system, a scanner can be used to scan an input copy; (citing col. 8, lines 8-30);

and a scanned component converter adapted to convert scanned components of said book into said digital representation (the Examiner argued like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information . The Examiner argued that with the scanning of an input copy and producing a movie or some non-static information, the conversion of scanned information into a movie or other non-static information, the conversion of scanned information into a movie or other non-static information is understood to be in a digital representation; (citing Warmus col. 8, lines 8-30).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a book scanner adapted to scan the components of said book; and a scanned component converter adapted to convert scanned components of said book into said digital representation in order to have a scanner which scans an input copy (citing Warmus, col. 8, lines 8-10).

Regarding claim 31, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said equipment specific format converter comprises: a Processor adapted to create a bitmap of the book block (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17, paragraph [0082]).

The Examiner admitted that however, Kato fails to teach Raster Image Processor.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses Raster Image Processor (i.e. like Kato, the Examiner argued the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus discloses having a RIP (Raster Image Processor) used to create bitmaps of book pages that can be displayed; (citing FIG. 6; col. 8, lines 63-67, col. 9, lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a Raster Image Processor adapted to create a bitmap of the book block in order to have a display device display pages (citing Warmus, col. 7, lines 24-31).

Regarding claim 32, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner argued that Kato discloses the system in claim 20, wherein step d) further comprises the step of: a Processor adapted to create a bitmap of the book cover (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17; paragraphs [0070] and [0082].

The Examiner admitted that however, Kato fails to teach Raster Image Processor.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses Raster Image Processor (i.e. like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus discloses having a RIP (Raster image processor) used to create bitmaps of book pages, which includes cover pages, which can be displayed: citing FIG. 6; col. 8, lines 63-67, col. 9, lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a Raster Image Processor adapted to create a bitmap of the book cover in order to have a display device display pages (citing Warmus, col. 7, lines 24-31).

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejection of claim 1 and 20 applies equally against the rejections of claims 3, 12, 13, 22, 31 and 32. Kato in view of Sangroniz and further in view of Warmus does not disclose: 1) converting the book files from

JDF into CNF, 2) storing the CNF files in memory within a repository and 3) determining if the CNF files need to be converted to equipment specific files.

Therefore, Kato in view of Sangroniz and further in view of Warmus fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims is not disclosed. Furthermore, the Examiner has not provided an explicit rationale to combine the references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C §103(a) rejections of claims 3, 12, 13, 22, 31 and 32 based on Kato in view of Sangroniz and further in view of Warmus.

Kato in view of Sangroniz and Clark et al.

The Examiner rejected claims 4-8, 18, 19, 23-27, 37 and 38 under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Sangroniz and further in view of Clark et al. (U.S. Patent Publication No. 2002/0152215) hereinafter referred to as "Clark".

Regarding claim 4, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato fails to teach disclose the method in claim 1, wherein said book identification information comprises the book title.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book title (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs {0022]-[0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraph s [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book title in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 5, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 1, wherein said book identification information comprises the book author (i.e. in the system, book identification information includes an author; (citing FIGS. 1-3; paragraphs [0007]-[0023]).

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book author (the Examiner argued that, i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book author in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 6, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 1, wherein said book identification information comprises the book publisher.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book publisher (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs {0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown in FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number an publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publisher in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 7, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 1, wherein said book identification information comprises the International Standard Book Number (ISBN).

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the ISBN (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022][0025]). The Examiner argued that the publishing

client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the ISBN in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 8, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 1, wherein said book identification information comprises the book publishing date.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book publishing date (i.e. the reference of Clark offers a print-on-demand titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publishing date in order to obtain information on eBooks or "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publishing date in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 18, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 1 wherein step e) comprises for electronic books, the step of: providing access to said book via an electronic link to a data network.

The Examiner argued that, however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein step e) comprises for electronic books, the step of: providing access to said book via an electronic link to a data network (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or a link, is sent to the user to provide access to the purchased eBook; (citing FIG. 16; paragraphs [0068]-[0074]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of an providing access to said book via an electronic link to a data network

in order to enable a consumer "print-on-demand" hard copies of a title (citing Clark, paragraph [0069]).

Regarding claim 19, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 1 wherein step e) comprises for electronic books, the step of: delivering said book to a predefined destination.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein step e) comprises for electronic books, the step of: delivering said book to a predefined destination (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or link, is sent to the user to provide access to the purchased eBook. The Examiner argued that the user then receives the eBook from the server (210) that handles distribution of the eBook. The Examiner argued that the feature of a link delivering a book to the predefined destination (e.g. the consumer client computer (208) over a data network (202); (citing FIG. 16-18; paragraphs [0068]-[0077]).

The Examiner argued that therefore, in view of Clark, it wou8ld have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein step e) comprises for electronic books, the step of: delivering said book to a predefined destination in order to enable a consumer "print-on-demand" hard copies of title (citing Clark, paragraph [0069]).

Regarding claim 23, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 20, wherein said book identification information comprises the book title.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book title (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference n umber and publication date: (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book title in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 24, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 20, wherein said book identification information comprises the book author.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book author (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles

that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book author in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 25, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach discloses the system in claim 20, wherein said book identification information comprises the book publisher.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprised the book publisher (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand' titles that t he publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publisher in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 26, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the method in claim 20, wherein said book identification information comprises the ISBN.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the ISBN (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022][0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the ISBN in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 27, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 20, wherein said book identification information comprises the book publishing date.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book publishing date (i.e. the reference of Clark offers a

print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing Clark, paragraph [0035]).

Regarding claim 37, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 20 wherein said book reproducer comprises for electronic books: an electronic link adapted to provide access to said book.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book reproducer comprises for electronic books: an electronic link adapted to provide access to said book (9.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or link, is sent to the user to provide access to the purchased eBook; (citing FIG. 16, paragraphs [0068]-[0074]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of an electronic link adapted to provide access to said book in order to enable consumer "print-on-demand" hard copies of a title (citing Clark, paragraph [0069]).

Regarding claim 38, the Examiner argued that the teachings of Kato in view of Sangroniz are disclosed above.

The Examiner admitted that however, Kato in view of Sangroniz fails to teach the system in claim 20 wherein said book reproducer comprises for electronic

books: an electronic link adapted to deliver said book to a predefined destination over a data network.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book reproducer comprises for electronic books: an electronic link adapted to deliver said book to a predefined destination over a data network (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022[-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or link, is sent to the user to provide access to the purchased eBook. The Examiner argued that the user then receives the eBook from the server (210) that handles distribution of the eBook. The Examiner argued that the feature of the server delivering the eBook to the consumer performs the feature of a link delivering a book to the predefined destination (e.g. the consumer client computer (208) over a data network (202); (citing FIGS. 16-18; paragraphs [0068]-[0077]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book reproducer comprises for electronic books: an electronic link adapted to deliver said book to a predefined destination over a data network in order to enable a consumer "print-on-demand" hard copies of a title (citing Clark, paragraph [0069]).

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejection of claim 1 and 20 applies equally against the rejections of claims 4-8, 18, 19, 23-27, 37 and 38. Kato in view of Sangroniz and further in view of Clark does not disclose: 1) converting the book files from JDF into CNF, 2) storing the CNF files in memory within a repository and 3) determining if the CNF files need to be converted to equipment specific files.

Therefore, Kato in view of Sangroniz and further in view of Clark fails in the aforementioned *prima facie* obviousness test as each and every limitation of the

Applicant's claims 4-8, 18, 19, 23-27, 37 and 38 is not disclosed. Furthermore, the Examiner has not provided an explicit rationale to combine the references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C §103(a) rejections of claims 4-8, 18, 19, 23-27, 37 and 38 based on Kato in view of Sangroniz and further in view of Clark.

III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §112 and §103 based on the preceding remarks. Reconsideration and allowance of Applicant's claims is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

Dated: February 13, 2009

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